

## REMARKS

This paper is presented in response to the final Office Action dated December 22, 2004, and is accordingly accompanied by a Request for Continuing Examination. This paper is also presented after a telephonic interview conducted on February 15, 2005, during which the Examiner suggested that a further interview may be useful upon the filing of this paper.

### **I. Status of the Application**

Claims 1-54 are pending. Of those, claims 1-5, 8, 9, 28-31, 37-41, and 49-54 are at issue, while claims 6, 7, 10-27, 32-38, and 42-48 have been withdrawn from consideration.

### **II. Summary of the Rejections**

Claims 1-5, 8, 9, 28-31, 37-41, and 49-54 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Fukai et al. U.S. Patent No. 4,542,452 ("Fukai"), either taken alone or in view of official notice taken by the Examiner. Reconsideration and withdrawal of the rejections are respectfully requested in view of the foregoing amendments and following remarks.

### **III. Interview Summary**

Applicants wish to express their appreciation of the courtesies extended by the Examiner during the telephonic interview conducted on February 15, 2005, during which the recitations of claim 1 were discussed in connection with the teachings of Fukai. Specifically, the definitions of the claim terms "controller" and "distributed process control system" were generally discussed in view of the programmer disclosed by Fukai. While specific definitions of the claim terms were not reached, Applicants stated that a controller in the process control context involves the implementation of process control routines. The Examiner, in turn, stated that a distributed process control system involves a process implemented using more than one controller or controlling device.

As set forth above, the Examiner expressed an interest in continuing the discussion regarding claim 1 in a further telephonic interview. Applicants look forward to the opportunity, and can be reached via the undersigned at the telephone number indicated below.

#### **IV. Summary of the Amendments**

By the foregoing amendments, claims 1, 3, 28, 39, 49, 51, and 53 have been amended.

##### **A. Amendments to Claims 1, 3, 28, and 39**

Independent claims 1, 28 and 39 have been amended to specify that the distributed process control system within which the controller can operate has a user interface with which the plurality of controllers is connected (i) to download configuration information and, (ii) to communicate further information during execution of the one or more programming routines. No new matter has been added by these amendments, inasmuch as support for these amendments can be found at, for example, the following portions of the application as originally filed: page 6, lines 17-24; page 8, lines 15-30; page 11, lines 18-30; page 12, lines 1-6 and lines 24-29; and, Figure 4.

Claims 28 and 39 have been further amended to specify that the second communication port is connected to an operator interface (rather than a user interface). Claim 3 has been amended in similar fashion (and to correct a typographical error). These amendments are not made for purposes of patentability, but rather made to avoid confusion with the user interface recited in claims 1, 28, and 39, as amended. Support in the application as filed for the operator interface can be found at page 7, lines 1-3. Nonetheless, the claim terms “user interface” and “operator interface” are used interchangeably in the application as originally filed (see, for example, page 4, lines 24-27). Thus, it is respectfully submitted

these amendments to claims 28 and 39 (and the corresponding amendment to dependent claim 3) should not be considered to be narrowing amendments.

**B. Amendments to Claims 49, 51, and 53**

Dependent claims 49, 51, and 53 have been amended to recite that the controller is connected with the user interface via the configuration communication port for communication of the configuration information and the further information. No new matter has been added by these amendments. See, for example, page 11, lines 28-30, of the application as originally filed.

**V. The 35 U.S.C. § 103(a) Rejection is Traversed**

Claims 1-5, 8, 9, 28-31, 37-41, and 49-54 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Fukai, either taken alone or in view of official notice taken by the Examiner. Applicants respectfully traverse these rejections, and the assertions and determinations therein, for at least the following reasons. Applicants accordingly request reconsideration and withdrawal of these rejections.

At the outset, under MPEP §§ 2142 and 2143,

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Citing, *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); see also MPEP § 2143-§ 2143.03 for decisions pertinent to each of these criteria.

Applicants respectfully submit that Fukai, either taken along or in combination with the official notice, fails to establish a *prima facie* case of obviousness of independent claims 1, 28, and 39 for the following reasons. Each independent claim, as amended, recites, in part, a controller that can operate as a stand-alone controller or as one of a plurality of controllers within a distributed process control system having a user interface with which the plurality of controllers is connected (i) to download configuration information and, (ii) to communicate further information during execution of the one or more programming routines. Fukai does not teach or suggest these elements for at least the following reasons.

To the extent that Fukai discloses a controller that can operate within a distributed process control system, Fukai fails to disclose a user interface of the distributed process control system with which the controller is connected to both download configuration information and to communicate further information during execution. In contrast, the controllers described in Fukai are programmed using a programmer that must be disconnected prior to execution of any process control routines. See, for example, col. 5, lines 59-68; col. 6, lines 1-6; and, col. 13, lines 23-27. Specifically, each controller is first configured individually using the programmer, after which the programmer is disconnected to enable the controller to move from a program mode to an execution mode. Thus, even if the programmer of Fukai can be considered to be a part of the distributed process control system during configuration, the programmer is disconnected during execution and, thus, does not provide a user interface with which the controller is connected to communicate information during execution, as recited in claims 1, 28, and 39, as amended.

None of the other user interfaces disclosed by Fukai as possibly connected to the controller are described as connected both to download configuration information and to communicate further information during execution. Specifically, the “upper computer or

operator console” is referenced in Fukai only generally in connection with “communication” (see col. 4, lines 11-14). Fukai fails to disclose or suggest any details regarding the nature of such communication, much less whether it involves downloading configuration information. On the contrary, Fukai suggests that such communication would not involve configuration, inasmuch as Fukai teaches a separate programmer for configuration and testing to address the shortcomings identified in the “Background of the Invention” section (col. 1, line 6 – col. 2, line 49).

To the extent that each controller of Fukai may also be configured via front and side panel interfaces of a controller, these panel interfaces cannot be considered to be a user interface of a distributed process control system with which the plurality of controllers is connected, insofar as the panels constitute parts of one of the controllers itself (see, e.g., col. 4, lines 14-22). For the same reason, any configuration information generated via these panel interfaces is not downloaded to that controller, much less a plurality of controllers.

For the foregoing reasons, it is respectfully submitted that Fukai fails to teach a controller that can operate within a distributed process control system, as recited in claims 1, 28, and 39.

Applicants further respectfully submit that Fukai also fails to suggest a controller that can operate as one of a plurality of controllers within a distributed process control system, as recited in claims 1, 28, and 39. If the controller of Fukai cannot operate unless it is disconnected from the source of programming information, then the controller of Fukai is incompatible with operation within a distributed process control system having a user interface with which the controller is connected to both download configuration information and to communicate further information during execution. That is, the controller of Fukai

would be rendered inoperable for its intended purpose if it remained connected within a distributed process control system, as recited in claims 1, 28, and 39, during execution.

For at least the reasons set forth above, it is respectfully submitted that Fukai fails to disclose or suggest every element of independent claims 1, 28, and 39. It follows that claims 1, 28, and 39 and, by implication, those claims dependent thereon, are patentable over the cited reference.

Applicants again respectfully traverse the assertion that it would have been obvious to modify the teachings of Fukai to include a MODBUS TCP communication port, as recited in claims 4, 30, and 41. Even if official notice is properly taken in this context, a suggestion or motivation to modify the teachings of Fukai is lacking because there is no disclosure or suggestion that the controllers disclosed by Fukai would benefit from a communications protocol designed for networked devices.

For at least the reasons set forth above, Applicants respectfully request allowance of the claims at issue, namely claims 1-5, 8-9, 28-31, 39-41, and 49-54. Furthermore, Applicants respectfully request allowance of the claims in Invention Group I (i.e., originally claims 1-39) held to be directed to non-elected species, insofar as each generic claim in the group should now be allowed. Accordingly, Applicants respectfully request allowance of claims 1-41 and 49-54.

## VI. Conclusion

Applicants have now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clearly apparent, Applicants respectfully request reconsideration and allowance of the claims at issue.

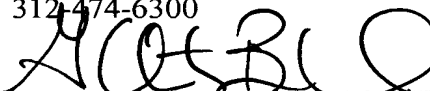
Although Applicants believe that the check attached hereto addresses any fees that are due as a result of the foregoing amendments, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 13-2855 of Marshall, Gerstein & Borun LLP. In addition, if a petition for an extension of time under 37 CFR 1.136(a) is necessary to maintain the pendency of this case and is not otherwise requested in this case, Applicants request that the Commissioner consider this paper to be a request for an appropriate extension of time and hereby authorize the Commissioner to charge the fee as set forth in 37 CFR 1.17(a) corresponding to the needed extension of time to Deposit Account No. No. 13-2855 of Marshall, Gerstein & Borun LLP. A copy of this paper is enclosed herewith.

If there are matters that can be discussed by telephone to further the prosecution of this application, Applicants respectfully request that the Examiner call their attorney at the number listed below.

Respectfully submitted,

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